

### REMARKS

The Applicants do not believe that entry of the foregoing amendment will result in the introduction of new matter into the present application for invention. Therefore, the Applicants, respectfully, request that the above amendment be entered in and that the claims to the present application, kindly, be reconsidered.

The Office Action dated April 26, 2004 has been received and considered by the Applicants. Claims 1-8 are pending in the present application for invention. Claims 1-8 are rejected by the April 26, 2004 Office Action.

The Office Action rejects Claims 1-8 under the provisions of 35 U.S.C. §103(a) in view of U.S. Patent No. 6,400,996 issued to Hoffberg et al. (hereinafter referred to as Hoffberg et al.) and over U.S. Patent No. 5,760,768 issued to Gram (hereinafter referred to as Gram). The Examiner states that Hoffberg et al. teach a method of customizing a graphical user interface for a computer controlled system having at least one selectable parameter. The Applicants would like to, respectfully point out that, Hoffberg et al. do not teach selectable parameters. The Examiner has in fact admitted as much in the Office Action by making the statement at the bottom of page 2 that Hoffberg et al. do not "teach the providing of actuatable means arranged so that a user can access the actuation to provide input to the display arrangements." The Applicants, respectfully, assert that the rejection contained within the Office Action fails at this point. The rejected claims define subject matter defining monitoring the selection of the selectable parameter by a user, and this element is not found in the rejection made by the Office Action.

The MPEP at §2143 under **Basic Requirements of a *Prima Facie* Case of Obviousness** states that in order to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

The Applicants, respectfully, assert that the rejection contained within the Office Action does not satisfy any of the above mentioned requirements for a *prima facie* case of obviousness. The first requirement is that there must be some suggestion or motivation, to modify or combine reference teachings. The Office Action does not provide the requisite suggestion or motivation. Hoffberg et al. teach pattern recognition that provides an adaptive interface but do not teach any selectable parameters. Gram teaches the customizing of a user interface but do not provide any pattern recognition by the system. The Examiner's position is that once combined, these references teach all of the recited elements to the rejected claims. The Applicants, respectfully, disagree. The Examiner has only used Gram for the recitation of the actuatable means, however, there is also the recitation for monitoring at least one selectable parameter, which is not found by the rejection contained within Office Action.

Regarding the second requirement for a reasonable expectation of success, the Office Action is silent. A person skilled in the art would not expect, as suggested by the Office Action, that the teachings of Gram could be applied to the teaching of Hoffberg et al. Moreover, a person skilled in the art would not expect to combine the teaching of Hoffberg et al. with that of Gram in a manner that would read on the rejected claims to the present invention. The reading of Hoffberg et al. with Gram done in the Office Action is accomplished in a manner that employs hindsight to recreate the invention using the recited elements to the rejected claims as a blueprint from which to pick and choose from prior art references the recited elements of the claimed invention. This hindsight approach is exactly the reason that the aforementioned requirements for a *prima facie* case of obviousness exist. The Office Action does not provide any reasonable expectation of success within the cited references.

The final requirement, that the prior art reference when combined must teach or suggest all the claim limitations, is also not met by the rejection contained in the Office Action. The rejected claims recite a graphical user interface for a computer controlled system having at least one selectable parameter. The Applicants would like to, respectfully point out that, Hoffberg et al. do not teach selectable parameters as asserted by the Office action. The Examiner has stated as much by making the statement that Hoffberg et al. do not "teach the providing of actuatable means arranged so that a user can access the actuation to provide input to the display arrangements." Without providing actuatable means there can be no selectable parameters.

The Applicants would like to, respectfully, point out that the rejected claims recite "actuatable means arranged so that a first actuation accepts the displayed optimized arrangement and a second activation cancels the displayed optimized arrangement." This element exists within all of the rejected claims and has not been addressed by the Office action. Therefore, there again exist unfound claimed elements in the rejection made by the Office action. The Examiner has used Gram for the recitation of the actuatable means, however, the actuatable means as recited being arranged so that a first actuation accepts the displayed optimized arrangement and a second activation cancels the displayed optimized arrangement is not even mentioned in the Office Action. Therefore, the final requirement that the prior art reference when combined must teach or suggest all the claim limitations, is again not met by the rejection contained in the Office Action. Accordingly, this rejection is, respectfully, traversed.

The foregoing amendment adds new claims 9-14, which are generally of similar scope to original Claims 1-8. Therefore, these claims are also believed to be allowable for the reasons stated above regarding Claims 1-8.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

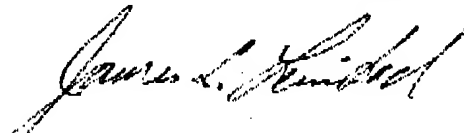
By 

James D. Leimbach, Reg. 34,374  
Patent Attorney (585) 381-9983

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence  
is being transmitted on this date via  
facsimile transmission to (703) 872-9306 AND addressed to:  
COMMISSIONER OF PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Date of Transmission: July 26, 2004

  
(Signature)